

## REMARKS

### The Response

Claims 1, 5, 8-12, 20-28, and 30 are pending.

### **Rejection Under §102**

Claims 1, 8-11, and 20-28 have been rejected under 35 U.S.C. §102(b) for allegedly being anticipated by J.M. Gomez-Vega et al., "A multilayer approach to fabricate bioactive glass coatings on Ti alloys", a paper available via Lawrence Berkeley National Laboratory (hereafter "the LBNL paper"). The Examiner asserts that:

"there are multiple citations of the paper clearly indicating that the **publication date** is December 1, 1998. Applicant has not provided any evidence to account for this discrepancy only arguments. Although the document may have been available to the public *online* on October 9, 2001, the document need not be made available to the public online to be considered within the definition of published. It is the position of the Office that the document was disseminated earlier in some sort of print form, specifically, on its publication date of December 1, 1998 until evidence has been produced to the contrary." (page 7; emphases in the original).

Applicants respectfully disagree with the Examiner's assertions and traverse this rejection.

Applicants hereby submit evidence in the form of further Declarations under 37 C.F.R. § 1.132 by Ms. Jean Wolslegel, the Reports Coordinator of Lawrence Berkeley National Laboratory ("LBNL") Library (with Exhibits A-C), and by the undersigned attorney of record detailing communication with Ms. Sharon Jordan, an Assistant Director at the United States Department of Energy, Office of Science and Technology Information ("OSTI"). Exhibits A-C correspond to the "multiple citations of the paper" stated by the Examiner. The Declarations provide evidence that:

- (1) the term "publication date" indicated in these papers is not the date in which the papers were made available to the public, and does **not** have the same meaning as the publication date of a "printed publication" within 35 U.S.C. §102(b),

- (2) the LBNL, the publisher of the paper indicated in Exhibit A and B did not make the paper available to the public prior October 9, 2001, and
- (3) OSTI, the publisher of the paper indicated in Exhibit C, could not have made the paper available to the public prior October 30, 2001.

Applicants respectfully assert that this evidence refutes the Office's position that "the document was disseminated earlier in some sort of print form, specifically, on its publication date of December 1, 1998". All of the publisher of the papers state that the respective papers were not made available to the public prior to October 9, 2001 or October 30, 2001. In addition, Applicants respectfully contend that the Examiner does not have evidence that the meaning of the term "publication date" found in these papers has the same meaning as the publication date of a "printed publication" within 35 U.S.C. §102(b). This "December 1, 1998" date coincides exactly with the date of the J.M. Gomez-Vega et al., "A multilayer approach to fabricate bioactive glass coatings on Ti alloys" presentation at the Materials Research Society (MRS) 1998 Fall Meeting on December 1, 1998, which the Examiner has agreed is not a printed publication under 35 U.S.C. §102(b).

Accordingly, the papers cited by the Examiner cannot be prior art to this present application under 35 U.S.C. §102(b), since the present application has a priority date of May 1, 2000. Since none of the cited papers are prior art under 35 U.S.C. §102(b), the Applicants respectfully request the Examiner to withdraw this rejection.

### **Rejection Under §103**

Claims 5, 12, and 30 have been rejected under 35 U.S.C. §103(a) for allegedly being rendered obvious by the LBNL paper, in view of Gomez-Vega et al., "Novel Bioactive Functionally Graded Coatings on Ti6Al4V" Advanced Materials 12(12): 894-897 (2000). Applicants respectfully disagree with the Examiner and traverse this rejection.

Claims 5, 12, and 30 are directed to a multilayer article comprising: a metal substrate, a first layer comprising an inner and outer surface, said first layer comprising a glass composition, a first intermediate layer having an inner and outer surface, and said first intermediate layer is located between the substrate and the first layer.

For the reasons provided earlier, the LBNL paper is not prior art.

The remaining disclosure, Gomez-Vega et al., "Novel Bioactive Functionally Graded Coatings on Ti6A14V" Advanced Materials 12(12): 894-897 (2000), alone does not teach or suggest a multilayer article comprising: a metal substrate, a first layer comprising an inner and outer surface, said first layer comprising a glass composition, a first intermediate layer having an inner and outer surface, and said first intermediate layer is located between the substrate and the first layer.

Accordingly, the cited papers fail to render Claims 5, 12, and 30 obvious under 35 U.S.C. §103(a). As such, the Applicants respectfully request the Examiner to withdraw this rejection.

### CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If in the opinion of the Examiner, a telephonic conference would expedite the prosecution of the subject application, Applicants encourage the Examiner to call the undersigned at (510) 486-4534.

If any fee is required to maintain pendency of this application, the Commissioner is authorized to charge any necessary and additional fees, including fees for additional extensions of time, that may be due to Deposit Account No. 120690, referencing Attorney Docket: IB-1627.

Respectfully submitted,

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